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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,536	05/22/2001	Richard Mcewan	604.30-US1	9172

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LAVA GROUP LAW BY SMITH & FROHWEIN, LLC
P.O. BOX 88148
ATLANTA, GA 30356

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/26/2004

. Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,536

Applicant(s)MCEWAN ET AL. **Examiner**

John W Hayes

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 1, 6 and 14 and added new claim 16 in the amendment filed 23 July 2004.

Response to Arguments

2. The amendment/arguments filed 23 July 2004 have been fully considered by the examiner but are not found to be persuasive.
3. With respect to the previous 35 USC 112 rejection, most of the issues have been resolved in view of applicant's amendments to the claims, however, there remains an issue with claim 14. Claim 14 depends upon claim 1 and recites "the ordering routine". Since there is no mention of an "ordering routine" in claim 1, claim 14 lacks antecedent basis for the term in the claim (See rejection below).
4. Applicant argues that, in the present invention, the search interface may be customized according to the branding graphic so that suggested keywords may be presented to the recipient who may then make a selection or enter a new search string and that the original e-mail could be updated on the fly as search results are generated. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., search interface may be customized according to the branding graphic so that suggested keywords may be presented to the recipient who may then make a selection or enter a new search string and that the original e-mail could be updated on the fly as search results are generated) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
5. Applicant further argues that Monahan et al teaches an initial search being conducted by a search server and that the search is conducted by inputting the search terms into a form communicated from a web site and further makes the assertion that the initial search routine does not take place within an e-mail client as in the present invention, but rather, is conducted from an Internet site. Examiner disagrees

Art Unit: 3621

with this assertion and submits that Monahan et al disclose a client machine outfitted with an HTML enabled e-mail client/browser (Figure 5) wherein a user may submit and receive searches and search results from within an HTML enabled e-mail client without the need for a browser. Monahan et al disclose that a form is communicated to a user wherein the user inputs search terms. The form is communicated to the user from a web site, however, this does not necessarily mean that the user must use a browser in order to receive the form. Examiner submits that the user may receive this form using the HTML enabled e-mail client.

6. Applicant also argues that Monahan et al does not teach or suggest conducting the entire search process within an e-mail client. Examiner submits that this interpretation is far more narrow than the claim language suggests. There is nothing recited in the claims that suggests the entire search process occurs within an e-mail client. The claims recite that a searching routine submits the search string to a search engine via a search interface, however, this does not limit the claim such that the search engine conducts the search entirely within the e-mail client. Examiner interprets the claim language such that the user submits the search terms to a search engine within the e-mail client and receives the results from the search engine within the e-mail client, however, the search engine itself may conduct the actual search using the Internet, which is what examiner submits is disclosed by Monahan et al (Figure 5). Furthermore, examiner submits the claim language "without using a browser" is interpreted as applying only to the returning of results. The claim is not written in a way to suggest otherwise.

Specification

7. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (Page 3, line 6). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3621

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "the ordering routine". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6, 8, 10-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan et al, U.S. Patent No. 6,523,037 B1.

As per **Claims 1 and 12-13**, Monahan et al disclose an interactive electronic commercial sent to a recipient comprising:

- a commercial message portion that includes a first branding graphic (Figures 12A-13)
- an interface portion that receives a search string designated by the recipient (Col. 5, lines 19-30; Col. 8, lines 30-49);
- a search engine interface (Col. 5, lines 19-30; Col. 8, lines 30-49; and
- a searching routine that submits the search string to a search engine via the search engine interface, and returns results to the recipient from within an e-mail client, without using a browser (Col. 5, lines 27-39; Col. 6, lines 25-31; Col. 7, lines 22-28 and 57-65).

Monahan et al discloses the use of banner ads within an e-mail, however, fails to explicitly disclose a branding graphic portion together with an interface portion that receives a search string. However, Monahan et al since shows the placement of a banner ad within an e-mail message (Figure

Art Unit: 3621

12B), examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that banner ads or other branding graphics may be placed within any e-mail message including an e-mail message that allows the entry of a search string such as the interface described above (Col. 5, lines 19-30; Col. 8, lines 30-49). Placing banner ads or other graphics within e-mail messages was well known at the time of applicant's invention and one would have been motivated to include this type of advertising within an e-mail as part of a marketing campaign in order to entice the consumer to purchase certain products.

As per **Claim 2**, Monahan et al further disclose wherein the search string is selected from a list of search strings presented to the recipient in the commercial (Figures 12-13).

As per **Claim 3**, Monahan et al further disclose wherein the interface portion contains a space into which the recipient types the search string (Col. 5, lines 19-30; Col. 8, lines 30-49).

As per **Claims 4-5**, Monahan et al further disclose wherein the search engine is a commercial searching facility available through a portal other than the commercial or through a web page of the internet (Col. 6, lines 22-31; Col. 12, lines 5-11).

As per **Claim 6**, Monahan et al further disclose wherein the search engine further comprises a graphical hyperlink to an Internet site (Figure 9A and 12B).

As per **Claim 8**, Monahan et al further disclose a results routine that returns a set of results to the recipient through an interface provided by the commercial based upon submitting the search string to the search engine. (Figure 9A, 12A-12B, 13).

As per **Claims 10-11**, Monahan et al further disclose an audio containing clip included within an email (Col. 9, lines 35-40).

Art Unit: 3621

As per **Claim 15**, Monahan et al disclose an interactive electronic commercial sent to a recipient comprising:

- providing the commercial with a commercial message portion that includes a first branding graphic (Figures 12A-13)
- the recipient opening the attachment and displaying an interface portion that receives a search string designated by the recipient (Col. 5, lines 19-30; Col. 8, lines 30-49); and
- an e-mail client submitting the search string to a search engine, and returns results to the recipient from within an e-mail client, without using a browser (Col. 5, lines 27-39; Col. 6, lines 25-31; Col. 7, lines 22-28 and 57-65).

Monahan et al discloses the use of banner ads within an e-mail, however, fails to explicitly disclose a branding graphic portion together with an interface portion that receives a search string. However, Monahan et al since shows the placement of a banner ad within an e-mail message (Figure 12B), examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that banner ads or other branding graphics may be placed within any e-mail message including an e-mail message that allows the entry of a search string such as the interface described above (Col. 5, lines 19-30; Col. 8, lines 30-49). Placing banner ads or other graphics within e-mail messages was well known at the time of applicant's invention and one would have been motivated to include this type of advertising within an e-mail as part of a marketing campaign in order to entice the consumer to purchase certain products.

As per **Claim 16**, Monahan et al disclose a method of sending an interactive electronic commercial sent to a recipient as an e-mail message comprising:

- providing an e-mail message to a recipient, the e-mail message including a commercial message portion (Figures 12A-13)

Art Unit: 3621

- the recipient opening the e-mail message displaying the commercial message portion and an interface portion, the interface portion being operable to receive a recipient designated search string (Col. 5, lines 19-30; Col. 8, lines 30-49); and

- an e-mail client that is operable to submit the recipient designated search string to a search engine, and returning a set of results from submission of the search string to the recipient from within an e-mail client, without using a browser (Col. 5, lines 27-39; Col. 6, lines 25-31; Col. 7, lines 22-28 and 57-65).

Monahan et al discloses the use of banner ads within an e-mail, however, fails to explicitly disclose a commercial message portion together with an interface portion that receives a search string. However, Monahan et al since shows the placement of a banner ad within an e-mail message (Figure 12B), examiner submits that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention that banner ads or other commercial messages may be placed within any e-mail message including an e-mail message that allows the entry of a search string such as the interface described above (Col. 5, lines 19-30; Col. 8, lines 30-49). Placing banner ads or other graphics within e-mail messages was well known at the time of applicant's invention and one would have been motivated to include this type of advertising within an e-mail as part of a marketing campaign in order to entice the consumer to purchase certain products.

12. Claims 7, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan et al, U.S. Patent No. 6,523,037 B1 in view of Fortenberry et al, U.S. Patent No. 6,101,485.

As per **Claims 7, 9 and 14**, Monahan et al disclose a banner ad within an e-mail message, however, does not specifically disclose an ordering routine through which the recipient orders a product. Fortenberry et al discloses a system for electronic solicitations using e-mail and enables a consumer to order products from within the e-mail message (Abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Monahan et al and include the

Art Unit: 3621

ability to order products from within an e-mail message as taught by Fortenberry. One would have been motivated to include an ordering routine to allow the consumer to purchase the products being promoted.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

15. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fortenberry et al disclose a method for electronic solicitations using e-mail allowing consumers to order products within an e-mail message and without going to the e-commerce site
- Shaw et al disclose an electronic mail system for displaying advertisements

Art Unit: 3621

- Salam et al disclose a system for submitting a search request using e-mail messaging, returning results to the user within an e-mail message and wherein a third party search engine performs the search functions.
- Hirsch discloses a search engine wherein users can submit a search using e-mail and get the results of the search within the e-mail
- Goedken discloses an electronic information exchange system and teach that a user requests information using e-mail and the result set is returned to the user within an e-mail client
- Snyder et al disclose a searching station accessed by terminals and teach wherein a user selects text to be submitted for a search and the results are supplied back to the user.
- Dustin et al disclose a method of delivering targeted, enhanced advertisements across networks.
- Tucciarone et al disclose an electronic messaging system and teach a search facility
- Sheldon et al disclose an e-mail messaging system and also disclose searching facility
- Glasser discloses a method of embedding advertisements in e-mail communications.
- O'Leary, Mick, "ReQUESTer Opens Lexis-Nexis to Web" teaches a software product that allows consumers to e-mail search requests and receive search results in an e-mail.

Art Unit: 3621

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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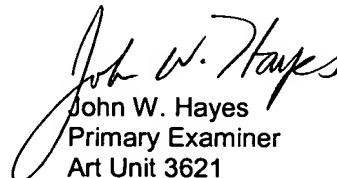
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John W. Hayes
Primary Examiner
Art Unit 3621

October 22, 2004